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Howard M Cohn  
Robert W Brown Dept 823  
The Goodyear Tire & Rubber Company  
1144 East Market Street  
Akron, OH 44316-0001

EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

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DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/719,705

Applicant(s)

ROESGEN, ALAIN EMILE  
FRACOIS

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 July 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Newly submitted claims 15-20 are directed to an invention (species) that is independent or distinct from the invention *originally claimed* for the following reasons:

New claims 15-18 are directed to a patentably distinct species of applying the underlay in the form of a single wide strip as distinguished from the originally claimed species limited to applying the underlay in the form of a wound ribbon.<sup>1</sup> In other words, the originally presented method claims only defined a single species of wrapping a ribbon whereas the newly presented claims define an additional species not previously claimed.

Similarly, new claims 19-20 are directed to a patentably distinct species of having the underlay be slightly smaller in width than the belt as compared to the originally presented claims which either were generic or only defined the species/embodiment in which the underlay was wider than the belt. In other words, the originally presented tire claims only defined a genus and single species of a wider underlay whereas the newly presented claims define an additional species not previously claimed.

Since applicant has received an action on the merits for the originally presented species/invention, *this invention has been constructively elected by original presentation for prosecution on the merits*. Accordingly, claims 15-20 are withdrawn from consideration as being directed to a non-elected invention (species). See 37 CFR 1.142(b) and MPEP § 821.03.

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<sup>1</sup> Note that original claim 10 was restricted to applying the underlay by wrapping a *ribbon* – this is distinguished in the specification (as well as in normal tire building terminology) from the application of a full width ply. Although claim 10 still defines forming the underlay by wrapping a *ribbon*, with an intent that this be apparently generic to either application method, this is considered to present a meaning that is inconsistent with the terminology used – this will be treated in a 35 USC 112 rejection to follow.

Note also that upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Claims 6 and 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 has been amended to define that the underlay “increases a web width” between the belt and ply. This is indefinite and confusing as it is not clear how this claim further limits claim 1 and if it is deemed to further limit, then the scope of protection afforded thereby is not readily ascertainable. In particular, if the “web width” is governed simply by the presence of additional space between the belt and ply, then it would seem that the presence of the underlay between the belt and ply, as already defined in claim 1, would necessarily increase a web width (as compared to having no underlay between the belt and ply) – how then does this further limit? Additionally, if is

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considered that it further limits, then what additional requirement is defined by this claim beyond simply the presence of increased space between the belt and ply? Further, the scope of this is also indefinite as it is not clear what this *increase* is relative to.

Additionally, as noted above, the language in claim 10 defining applying the underlay by *wrapping a ribbon* is now considered indefinite in light of the now expressed intent that this language be read to be generic to either application of a wrapped *ribbon* or application of a full width ply. In other words, since wrapping a *ribbon* is distinguished in the specification (as well as in normal tire building terminology) from the application of a full width ply, the indication that this language is to be read as generic to either application method is considered to be inconsistent with the wording used and thus raises a significant ambiguity.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 385,192 to Pirelli or FR 2,425,334 to Kleber Colombes as applied in the last office action.

5. Claims 1-3, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Willard, Jr. (US 5,511,599) as applied in the last office action.

6. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 385,192 to Pirelli or FR 2,425,334 to Kleber Colombes while claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willard, Jr. (US 5,511,599) as applied in the last office action.

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7. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roesgen et al. (US 5,332,018) or Welter (US 4,262,726) or Iwata et al. (US 4,842,682) or Cluzel (US 5,996,662) taken in view of Oare et al. (US 5,368,082) as applied in the last office action.

8. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roesgen et al. (US 5,332,018) taken in view of EP 335,588 to Sumitomo, Kohno et al. (US 5,054,532), GB 1,487,426 to Verbauwheide, and optionally Welter (US 4,262,726).

These references are applied herein for the same reasons as set forth in the last office action, the reference to Oare being removed from the rejection with the removal from these claims of any reference to a run-flat tire. Winding ribbons at 0-5 degrees as required by new claims 13 and 14 is extremely well known, conventional and obvious in forming essentially zero degree plies in tires.

9. Applicant's arguments filed 7-17-02 have been fully considered but they are not persuasive.

As to EP '192 to Pirelli, applicant points out that the Pirelli strip "7" can be positioned either inside or outside the belt whereas the underlay of the present invention is exclusively between the belt and radial ply. It is not clear if applicant is arguing that this somehow distinguishes the claimed invention from the reference – in any event, the fact that the reference discloses an additional alternative embodiment in no way takes away from the disclosure of positioning the strip inside the belt. It is also argued that the claim requires high-modulus cords whereas the reference is silent as to the modulus of the cords. This argument has been considered but is unpersuasive as neither the

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claim nor the specification provide any positive limits on the modulus range encompassed by the phrase "high-modulus", it therefore being considered reasonable to expect that any material suitable and effective for reinforcing a tire in the belt area can be termed "high modulus" as claimed.

It is also argued that the edges of the fabric underlay of the invention are not folded back, reference being made to the figures. While the figures may not show a folded structure, nothing in the present claims excludes the presence of folded edges. Further, as to the width defined in claim 2, the lateral margins of the layer "7" are reasonably considered to be the parts of the ply that extend the furthest in each lateral direction, this clearly being wider than the width of the belt ply. The discussion of the new claims defining a different width requirement have not been considered as they relate to claims that have been held to be directed to non-elected species.

As to FR '334, it should first be pointed out that what is identified by applicant as a "thick layer" between the plies is considered to not be a steel belt as assumed by applicant but rather, in light of the English abstract, is a thick hoop of rubber – in either case, however, nothing in the present claims distinguishes or defines over the presence of such a layer. In any event, it is argued that it is not apparent whether the inner ply 23.1 contains high modulus cords. This argument has been considered but is unpersuasive as first note that again neither the claim nor the specification provide any positive limits on the modulus range encompassed by the phrase "high-modulus", it therefore being considered reasonable to expect that any material suitable and effective for reinforcing a tire in the belt area can be termed "high modulus" as claimed. Further,

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note also that these belt plies are clearly described in the reference as “inextensible”, this tending to indicate that they are particularly high modulus. Finally, it seems apparent that this reference explicitly discloses high modulus cords such as metal cords – note page 2, lines 24-28.

As to Willard, Jr., applicant points out that the reference prefers metallic material for the reinforcement and then notes that the claims define a “fabric underlay”. It is not clear exactly what applicant is arguing here although it would seem that the argument is that the term “fabric” defines over metal cords. It however is not considered that there is any indication in the specification or claims that would indicate that this term is to be so read and further it is not considered that the term fabric as normally used defines any particular reinforcement material. In any event, even if it did, the reference even discloses using non-metal materials such as aromatic polyamide (col. 10, lines 10-13). The arguments pertaining to claim 19 have not been considered as again this claim has been held directed to a non-elected species.

As to the obviousness rejections of claims 3-5, it is argued that the references do not suggest the relative location to the neutral bending axis. While it would be agreed that the references do not use this terminology, it is again noted it would be a reasonable conclusion from their inner most relative location adjacent the carcass that the claimed requirement would be met or obvious from what is taught in the references and applicant has not conclusively shown why this is in error. The argument that there is no teaching as to why the claimed materials are obvious is unpersuasive as the reasons come from the fact again that the claimed materials were and are considered



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by the examiner to be inclusive of *well-known and conventional belt cord materials*, their use in the belt plies of EP '192 and FR '334 (the innermost layers of which are being considered to be an underlay as claimed) being therefore obvious. In fact, aramid materials are also well known substitutes for steel in belts. If it is applicant's position that they are challenging the assertion that these materials are well known belt cord materials, then this should be more clearly stated for the record, at which time the examiner will provide evidence therefore. It however is not considered at present that applicant has clearly challenged the examiner's *well known* statement in this regard and thus no evidence will be provided at this time.

The remaining arguments with respect to the last rejection of the tire claims do not clearly identify why each of the four alternative primary references do not teach what is claimed – the comment with respect to the requirement for a “high-modulus material” is not considered to define over the reference teachings for the same reasons noted above.

As to the method claims, as already noted, any claims directed to the newly claimed requirement for wrapping a single ply have been held directed to a non-elected species. The remaining method claims further have been read consistent with the specification to be directed to wrapping a *ribbon* to form the ply, i.e. a narrow helical ribbon, the term “ribbon” only being used in the specification in the context of a helically wound layer. With respect to the art rejection, applicant urges that figs. 1-2 wind a ply outward of the belt ply and thus do not teach a process as claimed. Again however, the examiner explicitly referenced **fig. 9** as the relevant embodiment, this embodiment

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clearly showing the wound ply underlying the belt, and thus applicants arguments with respect to figs. 1-2 not teaching the invention are unconvincing. Applicant's remaining arguments with respect to the secondary references are thus prefaced on an incorrect reading of the rejection and in any event are unconvincing as they principally relate to differences between each individual reference and the claimed invention rather than looking at the references taken as a whole and what they would motivate the artisan to do – again note the statement of rejection for the specific reasons the secondary references were applied.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

  
Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
October 16, 2002